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| 09/711,362 | 11/10/2000 | Yoshiaki Yokoyama | Yaguchi-0016 | 6786 |

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| EXAMINER |
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LEUNG, JENNIFER A

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| ART UNIT | PAPER NUMBER |
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1764

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/711,362

Applicant(s)

YOKOYAMA ET AL.

Examiner

Jennifer A. Leung

Art Unit

1764

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: Note the attached PTO-892.

Hien Tran
HIEEN TRAN
PRIMARY EXAMINER

Art Unit: 1764

Continuation of Item 11.

The request for reconsideration has been considered but does NOT place the application in condition for allowance because of the same reasons set forth in the Final Office Action. In addition, Applicant makes the following remarks:

Beginning on page 4, third paragraph, to page 7, third paragraph, Applicant argues,

“The Office Action surmises... that the difference between the location or arrangement of parts in the claimed invention and the invention in the cited reference “merely involves routine skill in the art, and one of ordinary skill in the art would have realized to locate the first hermetic door at such a location... in order to minimize the exposure of the door to deterioration by the vapors and metallic deposits, as suggested by Bassereau.”... The Official Action is using the Bassereau reference to provide the motivation to modify that reference when combined with the ‘549 Tejima reference to include a feature (namely, the orientation of the first hermetic door with respect to the second and third openings), when the Bassereau reference never teaches or even suggests such a feature. This interpretation begs the question that, if it would have been advantageous based on the teachings of the Bassereau reference to modify the structure described in the Bassereau reference to include the claimed features of the present invention, then why did the Bassereau reference not include these features? In fact, the Bassereau reference never teaches or even suggests modifying the teaching of the Bassereau reference to include the orientation of the first hermetic door with respect to the second and third openings...”

“The Official Action suggests that the rearrangement of parts involves only routine skill in the art and requires a showing of unexpected results in order to be patentable; however, no such requirement is present in U.S. patent law.... The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant’s specification, to make the necessary changes in the reference device.” No such motivation is present in either of the cited references.”

Art Unit: 1764

“The Applicants respectfully submit that the rejection is based on the improper application of hindsight considerations... Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations...”

The Examiner respectfully disagrees and maintains her rejection. The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, the Bassereau reference provides one of ordinary skill in the art with the suggestion for changing the location of the “first hermetic door” (i.e., the movable closure plate 9) to other suitable locations by teaching, specifically,

“In all cases, the sealing means [9] is preferably *placed beyond range of the vapors and is not exposed to deterioration by these vapors and metallic deposits.*” (column 2, lines 40-48).

Art Unit: 1764

In addition, motivation to modify the prior art in order to produce the claimed invention may arise from knowledge that is generally available to one of ordinary skill in the art, not necessarily found in the references themselves. In this case, the Examiner asserts that the shifting of location of parts (e.g., to other suitable locations that are beyond the range of the vapors, as suggested by Bassereau) is knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to shift the location of the first hermetic door in the modified apparatus of Tejima to the claimed location between the second opening and the third opening of the tube, because one of ordinary skill in the art would have recognized that such a location was beyond the range of the vapors, as suggested by Bassereau.

To further evidence that Applicant's claimed placement of the "first hermetic door" is merely conventional, the Examiner provides the following examples:

Small (US 3,152,479) discloses a first hermetic chamber (i.e., blast furnace, with wall 2) having a first opening (i.e., opening 4); a tube (i.e., probe 6) capable of inserting in the first opening 4, the tube 6 having a second opening (i.e., gas entry slot or slots 60) on a side facing the first hermetic chamber 2 and a third opening (i.e., an outlet 40) on the tube 6; and a first hermetic door (i.e., gate valve 68), placed outside the first hermetic chamber 2, capable of opening and closing the first opening 4, the first hermetic door 68 being positioned between the second opening 60 and the third opening 40 such that the first hermetic door 68 is shielded from the first hermetic chamber 2 by the tube 6 when insertion of the tube into the first opening 4 is completed. (see FIG. 1, 2),

Art Unit: 1764

Ueno et al. (US 4,054,060) discloses a first hermetic chamber (i.e., defined by furnace body **1**) having a first opening (i.e., front casing **29**, defining a lance insertion hole); a tube (i.e., lance **4**) capable of inserting in the first opening **29**, the tube **4** having a second opening (i.e., sampling port **4a**) on a side facing the first hermetic chamber **1** and a third opening (i.e., not shown; via a rubber hose for drawing sampled furnace gases, supported on a cable bearer **13**) on the tube; and a first hermetic door (i.e., gate valve **6**), placed outside the first hermetic chamber **1**, capable of opening and closing the first opening **29**, the first hermetic door **6** being positioned between the second opening **4a** and the third opening (not shown) such that the first hermetic door **6** is shielded from the first hermetic chamber **1** by the tube **4** when insertion of the tube **4** into the first opening is completed. (see FIG. 3-7).

The references to Kalwaitis (US 4,294,124), Dreuw et al. (US 3,832,904), Schneider (US 3,643,508), Mayes (US 4,630,939) and Kennedy (US 3,130,584) are further provided to illustrate the state of the art.

* * *

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Leung whose telephone number is (571) 272-1449. The examiner can normally be reached on 8:30 am - 5:30 pm M-F, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1764

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer A. Leung

September 6, 2005 *JAL*



**HIEN TRAN
PRIMARY EXAMINER**